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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,886	02/03/2004	Satoshi Sembo	600630-14US (563044)	1038

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2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

STITZEL, DAVID PAUL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/770,886	<b>Applicant(s)</b> SEMBO, SATOSHI	
	<b>Examiner</b> David P. Stitzel, Esq.	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/3/04; 2/14/05; &amp;</u> | 6) <input checked="" type="checkbox"/> Other: <u>5/16/05</u> .                         |

## OFFICIAL ACTION

### *Status of Claims*

Claims 1-9 are currently pending and therefore examined herein on the merits for patentability.

### *Claim Rejections - 35 U.S.C. § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102, which form the basis of the anticipation rejections as set forth under this particular section of the Official Action:

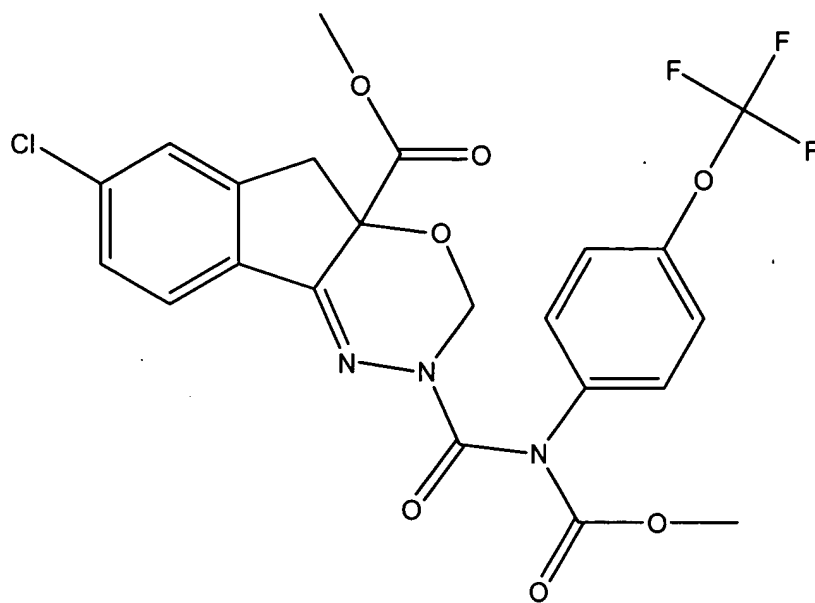
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-9 are rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application, Serial Number 09/968,175, which was filed by Asrar et al. on October 21, 2001, and subsequently published as a pre-grant publication (U.S. 2002/0115565) on August 22, 2002 (hereinafter the Asrar '175 application).

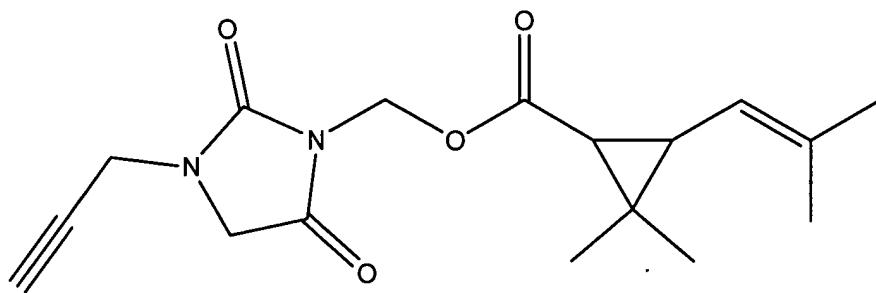
More specifically, claims 1-9 of the instant application are collectively directed to a method of controlling pests with a pesticidal composition comprising an oxadiazine compound of formula (A):



oxadiazine compound of formula (A)

(a.k.a., indoxacarb)

and a pyrethroid compound of formula (B):



pyrethroid compound of formula (B)

(a.k.a., imiprothrin)

(a.k.a., [2,5-dioxo-3-(2-propynyl)-1-imidazolidinyl]methyl chrysanthemate)

wherein the ratio of said oxadiazine compound to said pyrethroid compound is within the range of 50:1 to 1:10, and more preferably within the range of 20:1 to 1:4; wherein said pests are selected from the group consisting of mosquitoes, flies, termites, ants and cockroaches.

It should be noted that the oxadiazine compound of formula (A) is also known in the scientific literature as indoxacarb and methyl (S)-7-chloro-2,3,4a,5-tetrahydro-2-[methoxycarbonyl(4-trifluoromethoxyphenyl)carbamoyl]indeno[1,2-e][1,3,4]oxadiazine-4a-carboxylate. In addition, it should be noted that the pyrethroid compound of formula (B) is also known in the scientific literature as: imiprothrin; (2,5-dioxo-3-(prop-2-ynyl)imidazolidin-1-yl)methyl 2,2-dimethyl-3-(2-methylprop-1-enyl)cyclopropanecarboxylate); [2,5-dioxo-3-(2-propynyl)-1-imidazolidinyl]methyl chrysanthemate; and 1-propargyl-3,N-hydantoinylmethyl chrysanthemate.

Similarly, the Asrar '175 application discloses a method of controlling pests with an insecticidal composition comprising an oxadiazine derivative and a pyrethroid compound, namely imiprothrin; wherein the ratio of said oxadiazine derivative to imiprothrin is within the range of 1:1000 to 1000:1; wherein said pests are any insect or other pest that feeds on seed, root or foliage of a plant, said pests including, without limitation, mosquitoes, flies and ants (abstract, [0018]-[0019], [0023]-[0025], [0030]-[0032], [0034]-[0036], [0047], [0053], [0073]-[0076], [0085] and claims 1-3, 5 and 6). Although the Asrar '175 application does not explicitly disclose indoxacarb as being the oxadiazine derivative within the insecticidal composition, one of ordinary skill in the art would immediately envision indoxacarb as an insecticidal oxadiazine derivative as of the filing date (February 3, 2004) and the priority date (March 5, 2003) of the instant application. If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. See e.g., the

compendium of pesticide and insecticide common names as published on the internet on June 25, 2002 by the International Organization for Standardization ([http://web.archive.org/web/20020625100627/http://www.alanwood.net/pesticides/class\\_insecticides.html](http://web.archive.org/web/20020625100627/http://www.alanwood.net/pesticides/class_insecticides.html)); *In re Petering*, 133 USPQ 275 (CCPA 1962); and MPEP § 2131.02.

2. Claims 1-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,218,416, which issued to Sembo on April 17, 2001 (hereinafter the Sembo '416 patent).

As discussed hereinabove, claims 1-9 of the instant application are collectively directed to a method of controlling pests with a pesticidal composition comprising an oxadiazine compound, namely indoxacarb, and a pyrethroid compound, namely imiprothrin (a.k.a., [2,5-dioxo-3-(2-propynyl)-1-imidazolidinyl]methyl chrysanthemate), wherein the ratio of indoxacarb to imiprothrin is within the range of 50:1 to 1:10, and more preferably within the range of 20:1 to 1:4, wherein said pests are selected from the group consisting of mosquitoes, flies, termites, ants and cockroaches.

Similarly, the Sembo '416 patent discloses a method of controlling agricultural pests with a pesticidal composition comprising: a guanidine derivative; an oxadiazine compound, namely indoxacarb; and a pyrethroid compound, namely imiprothrin (a.k.a., [2,5-dioxo-3-(2-propynyl)-1-imidazolidinyl]methyl chrysanthemate); wherein the ratio of indoxacarb to imiprothrin is within the range of 98:1 to 1:98, which encompasses the claimed ranges of 50:1 to 1:10, and 20:1 to 1:4; wherein said pests are of the phylum Arthropoda and are selected from the group consisting of mosquitoes, flies, termites, ants and cockroaches (abstract; column 1 in its entirety; column 4 in its entirety; column 6, lines 7-11 and 39-47; column 7, lines 19-32, 52-56 and 59-62; and column 8, lines 6-25).

***Conclusion***

Claims 1-9 are rejected.

***Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Stitzel, Esq. whose telephone number is 571-272-8508.

The examiner can normally be reached on Monday-Friday, from 7:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Kunz can be reached at 571-272-0887. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*David P. Stitzel, Esq.*

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER